

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No. : 10/709,986 Confirmation No. 3985  
Applicant : Masato Gomyo et al.  
Filed : June 11, 2004  
T.C./A.U. : 3682  
Examiner : Thomas R. Hannon  
Docket No. : 18.021-AG  
Customer No. : 29453

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### **REPLY to Requirement for Restriction under 37 C.F.R. § 1.142**

Sir:

In response to the Office action of March 9, 2006, Applicants hereby elect Group 1. Claims 1-5, 9-13 and 17 are believed to encompass the elected invention. (This response is without traverse.)

Applicants' undersigned representative notes that MPEP 8<sup>th</sup> Ed. under 821.04, "Rejoinder," stated

[W]hen a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product . . . [A]pplicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. **Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right.**

(Emphasis added.) Whereas the original 8<sup>th</sup> edition of the MPEP thus mentions "presenting" process claims by amendment, the latest edition (October 2005 revision) addresses specifically the issue of withdrawn process claims. That is, section 821.04 has been rewritten to caution applicants that a withdrawn claim "that does not require all the limitations of an allowable claim will not be rejoined."

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More particularly, section 821.04 now states,

In order to retain the right to rejoinder, applicant is advised that the claims to the nonelected invention(s) should be amended during prosecution to require the limitations of the elected invention. **Failure to do so may result in a loss of the right to rejoinder.**

(Emphasis in the original.)

For the record, it is respectfully pointed out that the October '05 revision of section 821.04 of the MPEP does not state that applicants are no longer entitled to a right to rejoinder of withdrawn claims that depend from allowed elected claims, but merely cautions that the right of rejoinder is contingent on amending the withdrawn dependent claims such as may be required to accord with amendments made to gain allowance of the elected claims from which the withdrawn claims depend.

Favorable action by the Examiner at an early date is solicited.

Respectfully submitted,

April 10, 2006

/James Judge/

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